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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,826	07/23/2001	Katsuki Ogawa	IWA-173-PCT	1426

7590

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EXAMINER

OSTRUP, CLINTON T

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 05/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/889,826

Applicant(s)

OGAWA ET AL.

Examiner

Clinton Ostrup

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on July 23, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

DETAILED ACTION

Claims 1-31 are pending in this application.

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(a-d) as follows: An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). Although applicant has referenced the Japanese applications in the first line of the specification, applicant has failed to reference PCT/JP00/08328 in the specification.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

The correction of errors by using a correction fluid or correction tape, and then subsequently writing on said fluid or tape, makes said writing not in permanent ink, or its equivalent in quality, as required under 37 CFR 1.52(a). Therefore, the corrections to the oath wherein characters are written on correction fluid or correction tape are not permanent parts of the record. Thus, a newly submitted oath with corrections initialed and dated, written in permanent ink is required.

Specification

The disclosure is objected to because of the following informalities: a misspelling of the word "the" has been noted on page 2, last line of the specification. This and any

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other inadvertent errors to the specification, which are discovered by applicant, should be corrected by amendment to the specification. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 9-11 rejected under 35 U.S.C. 102(b) as being anticipated by

Ogata et al., 5,957,398. Ogata et al., qualifies as a 35 U.S.C. 102(b) reference because the effective US filing date of the instant application is the PCT filing date, November 27, 2001. However, even if applicant perfects the foreign priority documents by submitting certified translations of said documents, the Ogata reference would still qualify as prior art under 35 U.S.C. 102(a, e).

Ogata et al teach a method of making a composite ceramic material suitable for use as a pulverizing medium and teaches both wet and dry type pulverizing. The reference teaches that the powder may be used as a raw material in cosmetics and that a media agitating type of mill can be used to make powder dispersions. In Example 2, the reference teaches alumina-zirconia mixed powders being pulverized and mixed in a media agitating mill and then a binder being added to the mixture. Thus the reference clearly anticipates instant claims 1 and 9-11. See: col. 1, lines 5-38, col. 14, line 53 – col. 19, line 50, and abstract.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-10, 12-17, 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hockmeyer et al., EP 0,546,715 A1 and further in view of SUNSTAR INC, JP 09286713 A and ISHIHARA SANGYO KAISHA, LTD., WO98/16193.

Hockmeyer et al., provides a basket media mill and a method for dispersing powdered solids into liquid vehicles for the manufacture of paints, coatings, and inks. The reference teaches that their invention is effective in accepting unmixed pigment and liquid vehicle directly into the mixing vessel and then effectively grinds and disperses the pigment in the vehicle in a short amount of time. See: col. 1, line 1 – col. 2, line 15; col. 8, line 45 – col. 11, line 46; and abstract.

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Although the primary reference provides an apparatus and a general concept of the types of powders and vehicles which may be used, the primary reference lacks the specific powders, oils, and cosmetic products as claimed instantly in claims 1-31.

SUNSTAR INC teaches cosmetic compositions with improved dispensability by blending two powders and a solvent together via a wet grinding treatment in a medium stirring mill. The reference describes how the cosmetic cream exhibits an excellent ultraviolet rays blocking ability and an excellent dispersibility. See: abstract.

ISHIHARA SANGYO KAISHA, LTD., discloses ultraviolet-screening dispersions of particulate titanium dioxide in a stable silicone-base cosmetic material, said dispersion is prepared by dispersing particulate titanium dioxide in a silicone medium using a dispersant. See: abstract.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the general methods of dispersing powdered solids into liquid vehicles as taught by Hockmeyer et al., to formulate cosmetic compositions with ultraviolet blocking, skin protecting properties as taught by SUNSTAR INC and ISHIHARA SANGYO KAISHA, LTD because of the expectation that the methods of dispersing a powder into a liquid vehicle would easily be applied to a fine particulate titanium dioxide powder in a silicone-base cosmetic material. Furthermore, the method of filling and molding cosmetic products into containers using known methods would have been obvious to the skilled artisan, as the formulation must be processed into a usable form.

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Claims 11 and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined references above and further in view of KOSE CORP, JP 09-002816.

The combined references above teach methods of making cosmetic ultraviolet blocking formulations using a basket media mill, however, the combined references lack the particulate materials as claimed instantly in claims 11 and 18-24.

KOSE CORP teaches a modified clay mineral which has excellent gelation ability, imparts good thickening and thixotropic properties, and is capable of being used in cosmetics. The clay mineral is taught to give excellent preservation stability and usability in said cosmetics. See: abstract

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the method of making cosmetic ultraviolet blocking formulations as taught by the combined references above, by adding the clay mineral material as taught by KOSE CORP, because of the expectation of obtaining a method of making an ultraviolet blocking gelled formulation with good thickening and thixotropic properties as well as having excellent preservation stability and excellent usability.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clinton Ostrup whose telephone number is (703) 308-3627. The examiner can normally be reached on M-F (8:30am-5:00pm).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Clinton Ostrup

Examiner

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May 6, 2002



WILLIAM R. A. JARVIS
PRIMARY EXAMINER

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